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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,832	09/23/2003	Larry A. Christensen	P06486US1	4988
34082	7590	06/17/2005	EXAMINER GREEN, BRIAN	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			ART UNIT 3611	PAPER NUMBER

DATE MAILED: 06/17/2005

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/668,832  
Filing Date: September 23, 2003  
Appellant(s): CHRISTENSEN, LARRY A.

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Timothy J. Zarley  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 25, 2005.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Claimed Subject Matter***

The summary of the claimed subject matter contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection is correct.

**(7) *Claims Appendix***

The copy of the appealed claims contained in the Appendix is correct.

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**(8) Evidence Relied Upon**

4,194,629	Ledman et al.	03-1980
5,568,695	Kough	10-1996

**(9) Grounds of Rejection**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledman et al. (U.S. Patent No. 4,194,629) in view of Kough (U.S. Patent No. 5,568,695).

Ledman et al. shows in figures 1-2 a package (11,12) that includes a note (15) having indicia thereon. Ledman et al. does not specifically state whether the note is placed on the package and the specific message placed on the note defined in claims 1 and 5. Kough shows in figure 10 the idea of placing a note (60) on a package (44). In view of the teachings of Kough it would have been obvious to one in the art to modify Ledman et al. by placing the note directly on the package since this would make it clear that the note belongs with the package, would help to prevent the note and package from being separated, and would allow the message on the note to

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be clearly seen. Ledman et al. does not disclose the specific message (request that the package remain unopened) defined by the applicant in claims 1 and 5. It would have been obvious to one in the art to modify Ledman et al. by varying the message on the note since it is considered obvious to place any message on the note as desired, i.e. the particular indicia placed onto the note has been considered but it is not sufficient to distinguish the invention from the prior art (Ledman et al. in view of Kough) in terms of patentability. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the applicant's case, there is no functional relationship between the printed matter (message) and the substrate (note) which carries it. In regard to claim 2, the feeling of love is identified in the note of Ledman et al. In regard to claims 3 and 7, it is considered obvious to place any message as desired on the note, i.e. the particular indicia placed onto the note is not considered to be a patentable feature. In regard to claims 4 and 9, Ledman et al. does not disclose placing wrapping paper around the package. Kough shows in figure 10 the idea of placing wrapping paper (42) around a package (44). In view of the teachings of Kough it would have been obvious to one in the art to modify Ledman et al. by placing wrapping paper around the package since this would allow the package to be given to a recipient as a gift in a more aesthetically pleasing and surprising manner. In regard to claim 6, Ledman et al. shows in figure 1 that the package is a closed package. In regard to claim 8, as broadly defined, the package of Ledman et al. is considered to be a "gift-style container". In regard to claim 10, as broadly defined, the package of Ledman et al. is considered to be an envelope since it is something that envelops, see Webster's II New Riverside Dictionary which defines envelope as something that envelops.

***(10) Response to Argument***

The appellant argues that the Ledman reference does not teach a card on top of the box nor does it teach that the card include a request that the package remain unopened and does not suggest that the unopened package is filled with positive feelings. Ledman shows in figures 1 and 2 a box (11,12) that includes a card (15) having indicia thereon. The indicia (16) states that the box is filled with love, see figure 2. Ledman does not disclose whether the card is placed on the box. The appellant does not define in the claims that the card/note is placed on top of the package as argued above. The claims (claims 1 and 5) merely indicate that the note is placed on the package. The patent to Kough is being used to show that it is known to place a note onto a package, see figure 10, to achieve the advantage of making it clear that the note belongs with the package, to prevent the note from being separated from the package, and allow the note to be clearly seen. It would have been an obvious to one in the art to modify Ledman et al. by varying the message on the note since it is considered obvious to place any message on the note as desired, i.e. the particular indicia placed onto the note has been considered but it is not sufficient to distinguish the invention from the prior art (Ledman et al. in view of Kough) in terms of patentability. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the applicant's case, there is no functional relationship between the printed matter (message) and the substrate (note/card) which carries it.

The appellant argues that the examiner has failed to establish that there is a suggestion or motivation to modify Ledman et al., as proposed. The examiner disagrees since Ledman, et al.

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shows in figures 1 and 2 a note/card (15) which contains a message thereon. Ledman, et al. does not disclose whether the note (15) is placed on the package. The Kough patent is being used by the examiner to show that it is known to place a note (60) onto a package, see figure 10 of Kough. Attaching the note (15) to the package offers the advantage of making it clear that the note belongs with the package, helping to prevent the note and package from being separated, and allowing the message on the note to be clearly seen.

The appellant argues that independent claim 1 requires “placing a note on the package”, and independent claim 5 contains a similar limitation. Conversely, Ledman, et al., teaches carving the message into the box itself, or placing it within the box. The appellant asserts that this teaching of Ledman, et al., to insert the message within the box or carving the message into the box itself teaches away from the limitation of placing a note on the package so that the package may remain unopened. The appellant appears to believe that the examiner is calling the letters (33 or 35) in Ledman et al. as the note but this is incorrect. As discussed above, the note (15) shown in figures 1 and 2 in Ledman, et al. is considered to be the “note”. Figure 3 in Ledman, et al. is directed to a second embodiment and figures 4 and 5 are directed to a third embodiment. The examiner is relying only on the first embodiment (shown in figures 1 and 2) taught by Ledman, et al.

The appellant argues that Ledman, et al. in view of Kough fail to show the limitation that the note include “a request that the package remain unopened but suggesting that the unopened package is filled with the positive feelings”. The appellant argues that the step of having a “request that the package remain unopened but suggesting that the unopened package is filled with the positive feeling” is an essential feature of the present invention not shown in either piece

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of prior art. Ledman, et al. in view of Kough disclose all of the structure defined by the applicant in the claims except for the particular message on the note. Ledman, et al. discloses that the note (15) include a message thereon (message indicates that the box is filled with love, see figure 2). The only difference between the applicant's note and the Ledman, et al. note (15) is the specific words placed on the note. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cit. 1983). In the applicant's case, there is no functional relationship between the printed matter (message) and the substrate (note) which carries it.

The appellant argues that the printed indicia expresses the positive feelings to a recipient and requests that the package remain unopened and suggests that the package is filled with those positive feelings, provides a functional relationship between the package and the words in that these words are what create the expression of positive feeling that is being claimed. The examiner disagrees since the words appearing on the note/card are not functionally related to the substrate (card/note). The printed matter is simply printed onto the note/card. As indicated above, printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cit. 1983). In the appellant's case, there is no functional relationship between the printed matter (message) and the substrate (note) which carries it.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

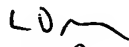



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bkg

June 9, 2005

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